

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF OHIO  
WESTERN DIVISION**

<b>SAVANNAH COLLEGE OF ART AND DESIGN, INC.,</b>	:	
	:	
Plaintiff,	:	<b>CASE No. <u>C-1-02-490</u></b>
	:	
<b>vs.</b>	:	
	:	
<b>PHILIPPE HOUEIX,</b>	:	Magistrate Hogan
	:	
Defendant.	:	
	:	

**DEFENDANT’S RESPONSE TO PLAINTIFF’S MOTION *IN LIMINE* TO  
EXCLUDE EVIDENCE AND ARGUMENTS REGARDING THIRD PARTY  
USES IN UNRELATED FIELDS**

Houeix use of *scad* does not compete with the college’s sale of educational services. Houeix web site does not sell a service or seek donations. On the inter net *scad* is included in more than sixty domain names of commercial sites and noncommercial or expressive sites.<sup>1</sup>

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<sup>1</sup> The following is a sampling of the domain names

www.scad.com	South Carolina Directory,. southcarolinaonline.com
www.scad.org	Smith County Appraisal District, smithcad.org
www.scad.ac.jp	Seian College of Art & design
www.scad.demon.co.uk	Skipton & Craven action for Disability
www.scad.uqam.ca	Service de Consultation en Analyse de Donne’s
www.scadskaters.org	Skating Club at Dartmouth
montic.de/html/scad.html	SCAD-Diving Suspended Catch Air Device
scad-group.com	SCAD-Group Copyright claimed
www.princeton.edu/scad	Support for Computing in Academic Department
scad.utdallas.edu	Systems and Control Archive at Dallas
www.rexscad.tripod.com	Supreme Court Advance Decisions
www.indexingsociety.ca/accueil.html	Society Canadienne pour l’analyse de documents
www.scadeaf.org	South Carolina Association of the Deaf
www.dsi.co.kr/scad.html	SCAD™1.0 Korean Corp. & US affiliate

Websites deal with *Scad* as of a coastal fish that has commercial uses. The acronym SCAD in medicine means Short-Chain Acyl-CoA Dehydrogenation disorder. In extreme sports, Suspended Catch Air Device diving has several web addresses using *scad*. SCAD is better known as Simplified CAD, or Structure CAD, engineering applications software, several computer companies have *scad* web addresses.

Plaintiff contends that evidence of unrelated-noncompeting use by third parties is irrelevant to this case. This ignores the dilution prong of the case. The cases<sup>2</sup> cited by Plaintiff are infringement determinations without any consideration of a dilution remedy. The strength of a mark is relevant to both consumer confusion for infringement, and to high level distinctiveness for dilution. In the dilution context of 15 U.S.C. §1125(c), one factor at (1)(G) is “the nature and extent of use of the ...mark by third parties.” Reported dilution decisions that apply (1)(G) consider third parties’ noncompeting and unrelated use.<sup>3</sup> Consequently Houeix evidence is relevant and admissible.

The legislative schemes for trademark infringement, 15 U.S.C. §1125(a) and trademark dilution, 15 U.S.C. §1125(c) carefully balance rights of the mark owner and the non-infringing user. There are no infringement rights for noncommercial use, noncompetitive use, fair use under 15 U.S.C. §1115(b)(4), and use that is unlikely to confuse a consumer as to the source of the good or service or affiliation with the mark owner. Dilution rights are not limited by consumer confusion, or by noncompetitive use. But dilution is limited by noncommercial use, fair use, and news commentary. The threshold limitation for dilution is the mark must be famous and have a very high degree of distinctiveness. Simply put the mark must be on the level of AUTOZONE, FORD, KODAK, DUPONT, or XEROX. It must attain the level of a household word for the dilution remedy.<sup>4</sup> There must be actual dilution.<sup>5</sup>

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<sup>2</sup> *Ameritech Inc. V. Am. Information Techs* 811 F.2d 960 (6<sup>th</sup> Cir. 1987); *Midwest Guaranty Bank v. Guaranty Bank*, 270 F.Supp. 2d 900, 912 (ED Mich 2003); *Daddy's Junky Music v. Big Daddy's Family Music*, 109 F.3d 275, 281 (6<sup>th</sup> Cir. 1997); *Nat'l Cable Television v. Am. Cinema*, 937 F.2d 1572, 1579-1580 (Fed Cir. 1991); *Tisch Hotels v. Americana Inn*, 350 F.2d 609, 614 (7<sup>th</sup> Cir. 1965); *National Lead Co. v. Wolfe*, 223 F.2d 195 (9<sup>th</sup> Cir. 1995)

<sup>3</sup> See for example *Avery Dennison v. Sumpton*, 189 F.3d 868, 875, 878 (9<sup>th</sup> Cir. 1999) a domain name decision, where evidence of third party internet use of *Avery* and *Dennison* was admitted.

<sup>4</sup> See *Thane International, v. Trek Bicycle*, 305 F.3d 894, (9<sup>th</sup> Cir. 2002) discusses the legislative history of 15U.S.C. 1125(c) noting that the mark must have a special *aura*; examples of dilution would be *DUPONT shoes*,

If the mark *scad* is not strong, there is little likelihood of confusion as to the college's affiliation with Houeix's web site, for the trademark infringement claim, 15 U.S.C. §1125(a). If the mark does not have the highest level of distinctiveness, there is no dilution under 15 U.S.C. §1125(c). Distinctiveness for dilution is much greater than distinctiveness for trademark registration.<sup>6</sup>

The college argues that any use of *scad* in a domain name, even noncommercial use such as occurs at *scad.info*, *scad.org* and *scad.com*, is infringement or dilution. In its motion it seeks exclusion of the evidence that sixty or more web sites use *scad* in their domain names, of evidence of the many registered businesses having *scad* in their names,<sup>7</sup> and the evidence of the expressive

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*BUICK aspirin and KODAK pianos. A mark will achieve broad-based fame only if a large portion of the general consuming public recognizes that mark. ....the mark must be a household name. In Avery Dennison v. Sumpton, 189 F.3d 868, 875 (9<sup>th</sup> Cir. 1999) it was noted Dilution is a cause of action invented and reserved [\*\*13] for a select class of marks - those marks with such powerful consumer associations that even non-competing uses can impinge on their value. At page 876 it noted to be capable of being diluted, a mark must have a degree of distinctiveness and 'strength' beyond that needed to serve as a trademark. Citing 3 McCarthy, at § 24:109.*

<sup>5</sup> *Autozone v. Tandy*, 373 F. Supp. 786, 804 (6<sup>th</sup> Cir. 2004); *Moseley v. V Secret Catalogue*, 537 U.S. 418, 123 S. Ct.1115 (2003)

<sup>6</sup> See ft. nt. 4, supra, page 876

<sup>7</sup> **STATE**

California  
Illinois  
Ohio  
Oregon  
Indiana  
Arizona  
Arizona  
Texas  
Georgia  
Florida  
Florida  
Florida  
Florida  
Florida  
Florida  
Florida  
Louisiana  
Nevada

**REGISTERED NAME**

SCAD International Trading, Inc.  
SCADWARE, Inc  
Scad Management, Inc.  
S.C.A.D. Industries  
SCAD's Enterprises Inc  
SCADA, Inc.  
SCADAPRO, Inc.  
Metso Automation Scada Solutions  
SCAD Oaks, Inc.  
SCAD, Inc.  
SCAD Company LTD  
SCADA Communication Systems, Inc.  
SCADAS, Inc.  
SCADA Services, Inc.  
SCAD Holdings, Inc.  
SCAD Partners, LTD  
SCADS Leasing, Inc.  
SCADA Specialist, Inc.  
Metso Automation Scada Solutions

use of *scad* on the inter net. A printout of USPTO records show nineteen other entities that applied for registration of trademarks containing *SCAD*.

Out side of Savannah Georgia. *scad* is not automatically associated with Plaintiff school, the college may have niche fame in Savannah Georgia, but that never rises to the high level distinctiveness required for dilution.

Contrary to the college's assertion, the majority view in the Sixth Circuit is that any use by third parties of a mark is relevant to a determination of confusion for infringement.<sup>8</sup>

For these reasons the Plaintiffs Motion in limine to exclude evidence of third party use must

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Nevada	SCADS, Inc.
Tennessee	SCADA Design Specialist
New Mexico	SCADA Source, LLC
Wyoming	SCADA Comm, Inc.
Michigan	SCAD Incorporated
Arkansas	Metso Automation Scada Solutions, Inc.
Maryland	SCAD, Inc.
Maryland	SCAD, Inc.
New York	SCAD Inc.
New York	SCAD Promotions, Inc.
New York	SCADA Systems, Inc.
South Carolina	SCADA Insurance Agency, Inc.
South Carolina	SCAD, Inc.
Pennsylvania	SCADA Solutions
North Dakota	Metso Automation Scada Solutions, Inc.

<sup>8</sup> See *Data Concepts*, 150 F.3d 620, 625 (6<sup>th</sup> Cir. 1998); *Big Time Worldwide Concert & Sport Club v. Marriott International, Inc.*, 236 F. supp. 791, 799, 800 (E.D. Mich 2003). "The greater the number of identical or more or less similar trade-marks already in use on **different kinds of goods**, the less is the likelihood of confusion. Indeed, courts have found extensive third-party uses of a trademark to substantially weaken the strength of a mark." *Homeowners Group v. Home Marketing Specialists*, 931 F.2d 1100, 1108, (6<sup>th</sup> Cir.1991). "In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other." 2 McCarthy, *Trademarks* § 11:85.

be over ruled.

Respectfully submitted,

/s/ John A.. Rebel  
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**Certification of Service**

The foregoing was served electronically on plaintiff's attorneys of record, on this 23<sup>rd</sup> day of September, 2004 .

/s/ John A.. Rebel  
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Attorney for Defendant